

REMARKS

The claims now in the case are claims 1-6.

The drawing were objected to under 37 CFR 1.83(a) because they failed to show a closed rear end of the U-shaped frame as described in the specification and identified as number 6. This objection is traversed.

New drawings have been supplied which meet with the PTO standards. The new drawings supply the identifying numeral, 6 for the closed rear end in Fig. 2. Any inconvenience caused by the omission of this obvious number from the original figure is regretted.

The very statement of this objection points out the fallacy of the objection. The portion of the specification which describes the subject matter which gives rise to this objection is paragraph [0035]. The subject matter in question is best seen from picturing Fig. 1 and Fig. 2 in combination. The specification states that the user sits or stands in a U-shaped frame 4. One side portion (the right side) of this frame is depicted in Fig. 1. The other side portion (the left side) is the mirror image of the first, and will exist on the other side (the left side) of the device. The next sentence describes the U-shaped frame as having a closed rear end 6, hand rails 8 along each of the sides 10 for aid in supporting the user, and an open front end 12. It is inconceivable how it can be stated that the U-shaped frame does not show a closed rear end 6 when Fig. 1 clearly shows the upright end portion of closed rear end 6 and Fig. 2 clearly shows the closed rear end, now numbered 6, connecting the two sides 10 and this feature is actually identified in the Examiner's statement indicating that it is not shown. It is believed that this objection may be withdrawn. If this explanation does not suffice, applicant's representative would

be pleased to offer further explanation over the phone or during an interview at the Examiner's convenience.

The Examiner objected to the original terminology, "Brief Description of the Drawing" in the specification as several drawings are presented. The heading has been corrected using the expression suggested in Section 608.01(a) of the MPEP. Removal of the objection is requested.

Claim 2 was objected to because of the presence of a clerical error. The Examiner's obvious attention to detail is appreciated. This clerical error has been corrected and it is believed that the objection may be removed.

Claims 1-6 were rejected under 35 USC 112, second paragraph.

It was held that the term "closed rear end" rendered claim 1 unclear because "it is not clear from the language of the limitation whether a sheet of metal, for example, is what makes the rear end of the device 'closed' or whether merely a bar connecting the two rear wheels makes the rear end of the device closed. This rejection is traversed.

While there does appear to be confusion, it is considered that the source of the confusion is not in the wording of the claim, but rather in the interpretation of the wording. A close reading of the claim reveals that the claim is directed to an ambulatory device. The device is described as containing several parts. One of these parts is the U-shaped frame. The U-shaped frame, not the device as urged by the Examiner, has a closed rear end. Whether the frame is closed by a bar as is illustrated in the drawings, a sheet of metal as is suggested by the Examiner, or by brick and block, it does not matter. What matters is that the frame has a closed rear end, two sides, and an open front end.

It is applicant's position that the Examiner has not established that one of ordinary skill in the pertinent art, when reading the claim in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claim. See the decision of Ex parte Wu, 10 USPQ2d 2031 (BPAI 1989) in this regard.

Should this rejection be repeated, the Examiner is requested to inform the applicant as to the level of skill which is characterized by one having ordinary skill in the pertinent art. Notice that the Ex parte Wu decision, *supra* indicates that the validity of a rejection under the second paragraph of 35 USC 112 depends upon whether one of ordinary skill in the pertinent art would be able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claim. Obviously, the correctness of the rejection cannot be determined unless the objective standard of one of ordinary skill in the pertinent art is known, conveyed to applicant, and used to make the scope ascertainment test.

Section 1701 of the MPEP states in part:

Every patent is presumed to be valid. 35 U.S.C. 282, first sentence. Public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

- (A) an examination of a reissue application of the patent,
- (B) a reexamination proceeding to reexamine the patent, or
- (C) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court.

U.S. Pat. Nos. 5,322,408, 5,665,041, 5,665,042, 5,848,956, and 6,467,797 contain terminology in their claims which is similar to that in the present claims. That is, their claims require a U-shaped "something" which has a closed end and the claims do not spell out the nature of the closed end or what it is made of. By saying that the language of the present claims would make the present claims unpatentable, the Examiner is, in effect, conveying his opinion as to the patentability of the claims of the above patents and many more such patents similar to them. As noted above, this is expressly prohibited by the M.P.E.P.

Should this rejection be repeated, the Examiner is requested to clearly point out how the claims of the above-identified patents comply with the statute whereas those of the present application do not while the claim terminology is quite similar.

Claim 2 was rejected under the second paragraph of 35 USC 112 in reciting "the winch electronic scale", this term lacking sufficient antecedent basis. This term resulted from a clerical error, which has now been rectified. It is believed that claim 2, as amended, complies with the statute.

Claim 2 was further rejected under the second paragraph of 35 USC 112 because it was not clear whether applicant intended for the electronic scale to be connected to the winch and the support bar by the support connectors recited in claim 1 or by other support connectors. Claim 2 has been amended to call for "the" support connectors. This term obviously refers back to the support connectors recited in claim 1, thus avoiding any confusion.

In light of the above remarks, it is considered that the rejection based upon 35 USC 112 (2) may be removed.

Claims 1 and 3-5 are rejected under 35 USC 102(b) as being anticipated by Mah. The teachings of this reference which are relied upon are clearly set forth in the paragraph bridging pages 4 and 5 of the Office Action. This rejection is traversed.

As the Examiner is well aware, a proper rejection under 35 USC 102 requires that every limitation set forth in the claim be shown by the reference.

Claim 1 requires a body halter having straps, which straps are connected by connectors to a swivel bar, which swivel bar is connected to a support bar.

It is the Examiner's position that Figs. 19, 23, and 25-28 show various types of body halters with straps. It is applicant's position that these figures fail to show a body halter having straps. Applicant cannot find any straps in these figures. It is requested that the Examiner point out where in the specification "strap" is disclosed in connection to a body halter. Figure 19 of the reference does refer to a body harness, but no straps are shown. Figure 23 does not show a body harness. Probably what the Examiner is referring to is the sling 202. A sling is not a body harness. Figures 25-28 do not show a body harness. These figures show a sling 214. A sling is not a body harness. It is noted that the slings do not show straps. According to the 2003 on-line Merriam Webster Dictionary, "strap" means a narrow usually flat strip or thong of a flexible material and especially leather used for securing, holding together, or wrapping or a band, plate, or loop of metal for binding objects together or for clamping an object in position. As the reference does not show a strap, the reference cannot show straps connected by connectors to anything.

Additionally, where the claim requires a support bar, the reference is relied upon to show a support bar 146 in Fig. 7. The item shown in Fig. 7 is referred to in the patent as being a shackle.

The 2003 on-line Mirriam-Webster Dictionary defines "bar" as being a straight piece (as of wood or metal) that is longer than it is wide and has any of various uses (as for a lever, support, barrier, or fastening), a solid piece or block of material that is usually considerably longer than it is wide <a bar of gold> <candy bar>, or a usually rigid piece (as of wood or metal) longer than it is wide that is used as a handle or support; *especially*: a handrail used by ballet dancers to maintain balance while exercising.

On the other hand, this source defines "shackle" as being a usually U-shaped fastening device secured by a bolt or pin through holes in the end of the two arms.

Clearly, the shackle of the reference is not the bar required by the claim.

Claim 3 requires that the large rear wheel contains a hand grasp. In the device of the prior art, it is evident that the large rear wheel does not contain a hand grasp.

Regarding claim 4, the claim requires that the device contains a seat. In the reference, Fig 19 shows the handrails required by claim 4. In this figure, there is no seat. The Examiner is not permitted to take one part from one figure and combine it with one part from another figure. The reference must show all parts in a single disclosed embodiment. It is evident that the claim requires a seat and hand rails. It is also evident that the reference shows a seat or handrails. This showing cannot anticipate the claim.

Claim 2 was rejected under 35 USC 103(a) as being unpatentable over Mah in view of Jones. Mah was relied upon as teaching all of applicant's claimed invention except for an electronic scale. Jones was relied upon as teaching an electronic scale in

order to indicate the amount or percentage of the patient's weight the patient is to wear during the physical therapy session. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an electronic scale on the Mah device as taught by Jones in order to indicate the amount or percentage of the patient's weight the patient is to bear during a physical therapy session. This rejection is traversed.

For the reasons just set forth, it is considered that the independent claim is patentable. Under the doctrine of In re Fine, 5 USPQ2d 1596, (Fed Cir. 1988), once a broad, independent claim is patentable over the prior art, the narrow, dependent claim is likewise allowable.

A determination as to whether a valid rejection has been made begins with ascertaining that the PTO policy regarding the guidelines laid down by the Supreme Court in Graham v. John Deere, 148 USPQ 459 (1966) has been carried out. The PTO policy is simply that patent Examiners carry the responsibility of making sure that the standard of patentability enunciated in this decision is applied in each case.

The first factual inquiry required by Graham is determining the scope and content of the prior art.

For the reasons set forth regarding the rejection of claim 1, it is considered that the Examiner has not correctly resolved this factual inquiry. The Examiner has attributed teachings to the prior art which are not contained therein. When the prior art is misinterpreted, it cannot be said that the Examiner has determined the scope and content of the prior art.

The second factual inquiry required by Graham is the ascertainment of the differences between the prior art and the claims in issue.

The Examiner has not identified the differences existing between the prior art and the claim due to the requirements in the claim of a body halter containing straps and a support bar. The Examiner has identified the difference that exists between the prior art and the claim due to the requirement in claim 2 of an electronic scale located above the winch and the electronic scale is connected to the winch and the support bar by the control connectors. It may be said that this inquiry factor has been partially resolved.

The third factual inquiry required by the Graham decision is the determination of the level of ordinary skill in the pertinent art. The Fed. Cir. stated in the decision of *Ryko Manufacturing Co. v. Nu-Star, Inc.*, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991):

Appellant asserts legal error in the failure of the district court to resolve the level of ordinary skill in the art. The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry. Instead of ascertaining what was subjectively obvious to the inventor at the time of invention, the court must ascertain what would have been objectively obvious to one of ordinary skill in the art at such time. Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered.

Is the level of ordinary skill that of an engineer seeking to improve on the device of Mah? Is it that of a user of the prior art device disclosed by Mah? Is it that of a physical therapist? In order to apply an objective standard in determining the obviousness of applicant's invention, it is necessary that this determination be made by the Examiner. In order to enable the applicant to make a reasoned reply based on objective standards, the results of this determination should be conveyed to applicant.

This is required by case law and has not been done. Thus, the third factual inquiry required by the Graham decision has not been carried out.

The fourth factual inquiry required by Graham involves the treatment of the invention as a whole and the evaluation of secondary considerations.

There are three basic criteria set forth in section 706.02(j) of the M.P.E.P. which must be met before a *prima facie* case of obviousness is made out.

The first of these is some suggestion or motivation to combine the references. This motivation appears to be missing. The claim requires that an electronic scale is located above the winch and the electronic scale is connected to the winch and the support bar by the control connectors. In the Jones reference, an electronic scale is located on the far right of the device apparently in easy reach of the patient whereas the hoist (winch) is located on the far left and may not be accessed by the patient. There does not appear to be any teaching in the Jones reference to locate the scale above the hoist to make it inaccessible to the patient.

The second criterion is that there must be a reasonable expectation of success. One would not anticipate that the placing the scale of Jones above the hoist of Jones would be successful in accomplishing the goals of the scale as discussed in the Jones reference.

The third criterion is that the prior art references, when combined, must teach all of the claim limitations. As neither reference teaches a support bar, it cannot be said that the combination of references as proposed by the Examiner would result in a scale located between the winch and a support bar. It may be said that this inquiry factor has not been resolved.

Claim 3 is rejected under 35 USC 103(a) as being unpatentable over Mah in view of Colpron. It is the Examiner's position that Mah teaches all of applicant's claimed invention except for hand grasps on the rear wheels. Colpron is cited to show an ambulatory device including large rear wheels with hand grasps in order to permit the rider to self-propel the device. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide hand grasps on the rear wheels of the Mah device as taught by Colpron in order to permit the rider to self-propel the device. This rejection is traversed.

It is first noted that The Examiner's admission that the Mah reference does not teach all features of the device of claim 3 reinforces the applicant's comments regarding the rejection of this claim under 35 USC 102.

For the reasons set forth in the discussion of the rejection of claim 1, it is considered that the independent claim is patentable. Under the doctrine of In re Fine, 5 USPQ2d 1596, (Fed Cir. 1988), once a broad, independent claim is patentable over the prior art, the narrow, dependent claim is likewise allowable.

As with claim 2 the propriety of the rejection of claim 3 will be looked at by examining the four Graham inquiry factors.

The first factual inquiry required by Graham is determining the scope and content of the prior art.

For the reasons set forth regarding the rejection of claim 1, it is considered that the Examiner has not correctly resolved this factual inquiry. The Examiner has attributed teachings to the prior art which are not contained therein. When the prior art is

misinterpreted, it cannot be said that the Examiner has determined the scope and content of the prior art. Thus, the first factual inquiry has not been resolved.

The second factual inquiry required by Graham is the ascertainment of the differences between the prior art and the claims in issue.

As noted with the rejection of claim 2, the Examiner has not identified the differences regarding a body halter containing straps and the existence of a support bar. The Examiner has identified the difference concerning a hand grasp. It may be said that this inquiry factor has been partially resolved.

The third factual inquiry required by the Graham decision is the determination of the level of ordinary skill in the pertinent art. This issue has not been addressed by the Examiner and has certainly not been resolved.

The fourth factual inquiry required by Graham involves the treatment of the invention as a whole and the evaluation of secondary considerations.

There are three basic criteria set forth in section 706.02(j) of the M.P.E.P. which must be met before a *prima facie* case of obviousness is made out.

The first of these is some suggestion or motivation to combine the references. This motivation appears to be missing. Why would one put hand grasps on wheels which are not intended to be turned manually? The Mah device is intended to be pushed from behind. The user would not be able to reach the wheels.

The second criterion is that there must be a reasonable expectation of success. Since the user could not reach the wheels of the Mah device, no one would expect that attaching hand grasps to the wheels would be successful for any purpose.

The third criterion is that the prior art references, when combined, must teach all of the claim limitations. The claim requires the presence of a body halter containing straps. This is not taught by the prior art. The claim requires the presence of a support bar. This is not taught by the prior art.

It is thus seen that the four Graham inquiry factors have not been resolved, and it is considered that this rejection is improper.

Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Mah in view of Santmann. The Examiner states that the primary reference does not show that the seat is foldable. The Examiner also urges that the secondary reference shows an ambulatory device including a foldable seat. It is concluded by the Examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a foldable seat on the Mah device as taught by Santmann in order to provide a means for the user to rest, which seat may be raised as desired. This rejection is traversed.

For the reasons set forth in the discussion of the rejection of claim 1, it is considered that the independent claim is patentable. Under the doctrine of In re Fine, 5 USPQ2d 1596, (Fed Cir. 1988), once a broad, independent claim is patentable over the prior art, the narrow, dependent claim is likewise allowable.

The four Graham inquiry factors will once again be reviewed to determine the propriety of this rejection.

The first factual inquiry required by Graham is determining the scope and content of the prior art.

For the reasons set forth regarding the rejection of claim 1, it is considered that the Examiner has not correctly resolved this factual inquiry. The Examiner has not made of record differences which exist between the primary reference and claim 1.

The second factual inquiry required by Graham is the ascertainment of the differences between the prior art and the claims in issue.

The Examiner has failed to point out that the independent claim requires a body halter with straps. The Examiner has failed to point out that the prior art fails to teach a support bar by as is required by the independent claim.

Further, the Examiner has failed to point out that the various patient support modules of the primary reference are interchangeable and are not intended to be used together. Thus, as pointed out above, the Mah device may have the transport chair or the handle frame, but never both together. Thus, the second Graham factor inquiry has not been met.

The third factual inquiry required by the Graham decision is the determination of the level of ordinary skill in the pertinent art. As noted above, this factual inquiry has not been resolved or addressed.

The fourth factual inquiry required by Graham involves the treatment of the invention as a whole and the evaluation of secondary considerations.

As pointed out above, there are three basic criteria set forth in section 706.02(j) of the M.P.E.P. which must be met before a *prima facie* case of obviousness is made out.

The first of these is some suggestion or motivation to combine the references. No motivation can be found in the references for the Examiner's suggested combination. Mah's invention is a detachably mounted patient support module mounted to the platform

32 of the device 30. This patient support module can be a transport chair, a commode seat, a handle frame, or a suspension frame.

The device of Santmann requires a pivoting seat and four upwardly extending legs. The seat is pivoted between an upward, inoperative, position and a downward, operative, position by moving a lever. For operation of the device, a hydraulic system is required. This hydraulic system attaches at one end to one of the front upwardly extending legs. Thus, a front upwardly extending leg is a required element of the Santmann device. There is no front upwardly extending leg in the Mah device. If one cannot attach a feature to make it operable, there is no motivation to attach it.

The second criterion is that there must be a reasonable expectation of success. The expectation seems to be missing.

In a first instance, if the patient support module were a transport chair which was somehow made to be capable of pivoting out of the way, the Mah device would offer no support for the patient. In a second instance, if the patient support module were a commode seat which was somehow made capable of pivoting out of the way, the results could be worse than in the first instance. In a third instance, if the patient support module were a handle frame, the device as proposed by the Examiner would be impossible to construct. In a fourth instance, if the patient device module were a suspension frame as portrayed in figure 23, and the seat as somehow made to pivot out of the way, the patient would be unable to do anything but stand still with arms extended.

The third criterion is that the prior art references, when combined, must teach all of the claim limitations. The combination as proposed by the Examiner would lack the body halter with straps. It would lack a support bar. It might lack the open front end.

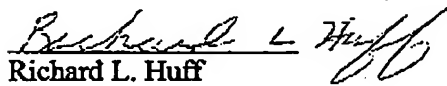
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In view of the above, it is believed that the four Graham inquiries have not been resolved as to claim 6 and it is considered that the rejection may be withdrawn.

The Examiner's attention is called to applicant's later-filed application, Ser. No. 10/055,330.

In view of the above amendments and remarks, it is believed that claims 1-6 are allowable and a notice to that effect is solicited.

Respectfully submitted,


Richard L. Huff
33627
(301) 924 2169